



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,715	06/14/2005	Marie-Laure Fardeau	BJS-1721-94	1999
23117	7590	01/12/2010		
NIXON & VANDERHYE, PC			EXAMINER	
901 NORTH GLEBE ROAD, 11TH FLOOR			KIM, TAEYOON	
ARLINGTON, VA 22203				
			ART UNIT	PAPER NUMBER
			1651	
			MAIL DATE	DELIVERY MODE
			01/12/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,715	Applicant(s) FARDEAU ET AL.
	Examiner TAEYOUN KIM	Art Unit 1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 18 November 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 8 and 12 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 8 is/are allowed.
 6) Claim(s) 12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement (PTO-1448)
 Paper No(s)/Mail Date 11/18/09.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

Applicant's amendment and response filed on 11/18/2009 has been received and entered into the case.

Claims 1-7 and 9-11 are canceled, and claims 8 and 12 are pending and have been considered on the merits. All arguments have been fully considered.

Claim 8 is allowable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claim discloses an isolated bacterial strain of an *Exiguobacterium lactigenes*, and the strain comprising a 16S rRNA sequence of SEQ ID NO:1 and further comprising a DNA sequence at least 70% of the DNA sequence being capable of hybridizing with genomic or plasmid DNA of the strain deposited with No. I-2962, and the strain having properties of thermoresistant, saccharolytic, amylolytic, producing L(+) lactate, growth properties at temperatures of 40-50°C, at pH 5.4-9.15 and a guanine and cytosine content being approximately 50 mol% .

The scope of the claimed strain is extremely broad encompassing not only the strain deposited with No. I-2962, but also any mutant and/or variant of the strain (I-2962) having at least of 70% of any segment of their DNA sequence can hybridize with the genomic or plasmid DNA of I-2962 strain. The specification discloses that the mutants of the strain conserving at least a 70% capacity for hybridization with the genomic DNA of the deposited strain (p. 3, lines 34-38).

However, the specification does not provide written description to support the possession of the isolated mutant strains of I-2962, having the property as disclosed in the instant claim, by the inventors. The only isolated strain having the claimed property disclosed in the specification is the deposited strain with deposit No. I-2962.

Therefore, it is construed that the specification does not provide written description in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the entire scope of the claimed invention other than the deposited strain (I-2962).

M.P.E.P. §2163 states “To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.”

M.P.E.P. § 2163 also recites, “An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention...

one must define a compound by 'whatever characteristics sufficiently distinguish it'. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process." and further, "The description needed to satisfy the requirements of 35 U.S.C. 112 "varies with the nature and scope of the invention at issue, and with the scientific and technologic knowledge already in existence." *Capon v. Eshhar*, 418 F.3d at 1357, 76 USPQ2d at 1084.< Patents and printed publications in the art should be relied upon to determine whether an art is mature and what the level of knowledge and skill is in the art. In most technologies which are mature, and wherein the knowledge and level of skill in the art is high, a written description question should not be raised for claims >present in the application when originally filed,< even if the specification discloses only a method of making the invention and the function of the invention. See, e.g., *In re Hayes Microcomputer Products, Inc. Patent Litigation*, 982 F.2d 1527, 1534-35, 25 USPQ2d 1241, 1246 (Fed. Cir. 1992) ("One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out."). In contrast, for inventions in emerging and unpredictable technologies, or for inventions characterized by factors not reasonably predictable which are known to one of ordinary skill in the art, more evidence is required to show possession."

Applicant argued that the percentage of 70% homology or DNA-DNA hybridization or relatedness would be acceptable in the art, referring Wayne et al. It is understood that the percentage cited by Wayne et al. is a criteria for a phylogenetic definition of species, and it is understood that certainly there are strains belong to the same species of *Exiguobacterium lactigenes*. Considering the broadest scope of the instant claim and a single species (strain) disclosed in the specification (e.g. 1-2962), it is not considered that the specification provides the written description that the inventors possess entire strains of a species of *Exiguobacterium lactigenes* as claimed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAEYOON KIM whose telephone number is (571)272-9041. The examiner can normally be reached on 8:00 am - 5:00 pm ET (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Taeyoon Kim/
Primary Examiner, Art Unit 1651